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Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Steven M. Belz et al.

SYSTEM INCLUDING A DIGITAL
CAMERA AND A DOCKING UNIT FOR
COUPLING TO THE INTERNET

Serial No. US 10/017,809

Filed November 30, 2001

Group Art Unit: 2612
Examiner: Chriss S. Yoder, III

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APPEAL BRIEF

Applicants hereby appeal the final rejection of claims 1-7 and 9-15 of
the above-identified application.

REAL PARTY IN INTEREST

The present application is assigned of record to Eastman Kodak
Company. The assignee Eastman Kodak Company is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals and interferences.

STATUS OF CLAIMS

The present application was filed on November 30, 2001, with claims 1-8. In an amendment filed on October 17, 2003, Applicants canceled claim 8, and added new claims 9-15. Claims 1-7 and 9-15 are currently pending in the present application, and stand finally rejected under 35 U.S.C. §103(a). Claims 1-7 and 9-15 are appealed.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection.

SUMMARY OF INVENTION

An illustrative embodiment of a system in accordance with the invention is shown in FIG. 1, and described in the corresponding text at page 6, line 21, to page 7, line 3, of the specification. The system comprises a digital camera 300 having a docking interface 322 to facilitate connection with a docking unit 350. The docking unit 350 is configured to establish a connection with a network service provider 30, which may be an Internet service provider (ISP). The system further includes a content service provider 40, which communicates with the camera 300 via the network service provider 30. The content service provider 40 receives and stores digital image files uploaded from the digital camera 300, and stores and downloads digital image files and other information to the camera 300.

An example image capture and display process that may be implemented in the FIG. 1 system is illustrated in FIG. 2, and described in the corresponding text at page 15, line 24, to page 24, line 19, of the specification.

The present invention in the illustrative embodiment provides a number of significant advantages relative to conventional techniques. For example, as indicated at page 4, lines 12-24, the invention provides a system in which the same digital camera used for capturing images, and displaying the captured images, may also be used for displaying images provided by others which have been stored by a service provider and communicated by the service provider over a channel such as the Internet. Also, the digital camera and associated docking unit permit the direct

connection of the digital camera to the service provider in a cost effective manner, eliminating the need for an intermediate device such as a personal computer.

ISSUES PRESENTED FOR REVIEW

1. Whether claims 1-3 and 11 are unpatentable under 35 U.S.C. §103(a) over Japanese Publication No. 2000-232599 (hereinafter “Viktors”) in view of U.S. Patent No. 6,167,469 (hereinafter “Safai”) and in further view of U.S. Patent Application Publication No. 2001/0024236 (hereinafter “Sato”).

2. Whether claims 5-10 and 12-15 are unpatentable under §103(a) over Viktors in view of Sato.

GROUPING OF CLAIMS

With regard to Issue 1, claims 1 and 11 stand or fall together, claim 2 stands or falls alone, and claim 3 stands or falls alone.

With regard to Issue 2, claims 5-7, 9 and 10 stand or fall together, and claims 12-15 stand or fall together.

ARGUMENT

Issue 1

Applicants initially note that a proper *prima facie* case of obviousness requires that the cited references when combined must teach or suggest all the claim limitations, and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of claims 1-3 and 11, in that the Viktors, Safai and Sato references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a system including a digital camera and a docking unit that permits the digital camera to be coupled to a channel for communication with a service provider. The claim specifies that the digital camera includes a memory for storing captured digital images at a first image size and transferred digital images at a second image size that is smaller than the first image size. The captured digital images at the first image size are images captured by the digital camera, for transfer from the docking unit to the service provider over the established channel, while the transferred digital images at the second image size are transferred from the service provider to the docking unit over the established channel.

The Examiner argues that the above-noted limitations of claim 1 are obvious in view of the proposed combination of Viktors, Safai and Sato. However, these references, even if assumed for purposes of argument to be combinable, fail to meet the limitations of claim 1.

Applicants note that there is apparently no teaching in any of the cited references regarding the transfer of digital images from a service provider to a digital camera, via a docking unit that permits the digital camera to be coupled to a channel for communication with the service provider, such that the transferred digital images can be displayed on a viewable display of the digital camera. The Examiner acknowledges that Viktors fails to meet these limitations, and relies on Safai and Sato for the missing teachings. However, Safai and Sato fail to provide any teaching or suggestion regarding the claimed transfer of images from a service provider to a digital camera via a docking station that permits the digital camera to be coupled to a channel for communication with the service provider. In fact, certain teachings in Safai and Sato may be viewed as teaching away from the limitations in question. For example, Sato at page 3, paragraph [0040] thereof indicates that the electronic camera 10 is directly coupled to a network via "an external communication device 44" comprising a cellular or portable telephone, which is an arrangement that is incompatible with a docking unit. The Safai reference is similarly deficient in this regard.

The Examiner relies primarily on Safai as allegedly teaching the claim 1 limitations relating to storing captured digital images at a first image size and

transferred digital images at a second image size that is smaller than the first image size. Applicants note that this limitation explicitly requires an image size distinction between the captured images sent to a service provider and the transferred images received from the service provider. In other words, the claim requires that the captured images sent to the service provider be of a different size than the transferred images received from the service provider. No such image size distinction is made in Safai or any of the other art of record between captured images sent to a service provider and transferred images received from a service provider. Moreover, to the extent the cited references fail to make this image size distinction that is explicitly recited in claim 1, the references are teaching away from the claimed invention.

Inasmuch as independent claim 1 includes limitations not taught or suggested by the combined teachings of Viktors, Safai and Sato, the Examiner has failed to establish a *prima facie* case of obviousness.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for combining the references or modifying the reference teachings to reach the claimed invention.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine the Viktors, Safai and Sato references to produce the particular limitations in question. Instead, the proposed combination appears to be based on a piecemeal reconstruction of the claimed invention, with the benefit of hindsight, rather than on any objective evidence of motivation.

More particularly, the Examiner states as follows in the final Office Action at page 3, section 3, regarding independent claim 1 and the proposed combination of the Viktors, Safai and Sato references, with emphasis supplied:

Safai teaches that the reduced size is preferred in order to allow the user to preview multiple images at one time i.e. thumbnails. Therefore, it would have been obvious to one of ordinary skill in the art to transfer and store the images in both large and small format in order to allow the user to preview multiple images. Sato discloses the use of a display in order to view the captured/received data and a processor to receive data from the network and cause it to be displayed. . . . Therefore it would have been obvious to one of ordinary skill in the art to modify the Viktors device to include a memory that can store a first and second size images, viewable display, a processor that receives data from the network and sends the data to the display, and the transfer of different size images between the camera and service provider in order to process and view the captured/received data on the display, and to display multiple images on the display.

Applicants submit that this statement is a subjective and conclusory statement of obviousness, and insufficient to support the proposed combination of the reference teachings. In addition, it fails to address the above-noted image size distinction between captured images sent to a service provider and transferred images received from a service provider. .

It therefore appears that the Examiner in formulating the §103(a) rejection of independent claim 1 has undertaken a piecemeal reconstruction of the claimed invention based upon impermissible hindsight, given the benefit of the disclosure provided by Applicants.

The §103(a) rejection of independent claim 1 is therefore believed to be improper, and should be withdrawn.

Dependent claims 2-3 and 11 are believed allowable for at least the reasons identified above with regard to independent claim 1. Moreover, these claims

are believed to define separately-patentable subject matter relative to the proposed combination of the Viktors, Safai and Sato references, as indicated below.

With regard to claim 2, this claim specifies that the processor further receives content files via the channel and causes information from such content files to be stored in the memory and to be displayed on the viewable display, the content files corresponding to content categories previously selected. The Examiner argues that these limitations are met by the proposed combination of Viktors, Safai and Sato, but fails to provide any objective evidence of motivation, stating instead that the combination or modification would be obvious because it would “make the information user selectable” (Final Office Action, page 4, first paragraph). This fails to meet the standard articulated by the Federal Circuit in the above-cited In re Sang-Su Lee case.

With regard to claim 3, this claim specifies that the channel is the Internet and when the digital camera is connected to the docking unit, the processor automatically causes the connection over the Internet to a predetermined service provider, and the predetermined service provider automatically provides the plurality of transferred images to the channel for transfer to the memory in the digital camera. Again, the Examiner argues that these limitations are met by the proposed combination of Viktors, Safai and Sato, but fails to identify any objective evidence of motivation, stating instead that the combination or modification would be obvious because it would allow “information to be easily obtainable by the user” (Final Office Action, page 4, section 5). This fails to meet the standard articulated by the Federal Circuit in the above-cited In re Sang-Su Lee case.

Issue 2

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of claims 5-7, 9 and 10, in that the Viktors and Sato references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 5 is directed to a system including digital cameras, docking units, and a service provider. The service provider includes a memory for storing a plurality of user accounts, each identifying particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories. The service provider communicates content information to digital cameras associated with the user accounts, whereby the content information, corresponding to content categories identified in the service account associated with each digital camera, is communicated over the Internet to the digital cameras via their respective docking units.

The Examiner relies on the combined teachings of Viktors and Sato. However, these references collectively fail to teach the claimed service provider memory configuration, and associated communication of content to digital cameras via associated docking units. Also, there is no objective evidence of motivation to combine the references or to modify their teachings to reach the limitations in question. The Examiner instead states that the combination would be obvious because it would “broaden the user base and communication area” (Final Office Action, page 6, first paragraph). It is improper for the Examiner to recite an advantage of the claimed arrangement as evidence of motivation to combine references or to modify reference teachings. Again, the standard set forth in In re Sang-Su Lee has not been met.

Dependent claims 5-7, 9 and 10 are believed allowable for at least the reasons identified above with regard to independent claim 5.

Applicants further submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of claims 12-15, in that the Viktors and Sato references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 12 is directed to a method for providing communication over a channel between a service provider and a plurality of digital camera users, where a given digital camera has an associated docking unit. The

service provider includes a memory for storing a user accounts, each identifying particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories. Content information is communicated to the plurality of digital cameras associated with the plurality of user accounts. The content information, corresponding to content categories identified in the service account associated with each digital camera, is communicated over the channel to the digital cameras. The digital cameras receive the content information and display it on a viewable display.

The Examiner again relies on the combined teachings of Viktors and Sato. However, these references collectively fail to teach the claimed service provider memory configuration, and associated communication of content to digital cameras via associated docking units. Also, there is no objective evidence of motivation to combine the references or to modify their teachings to reach the limitations in question, for substantially the same reasons identified above with regard to claim 5.

Dependent claims 13-15 are believed allowable for at least the reasons identified above with regard to independent claim 12.

In view of the foregoing, Applicants believe that claims 1-7 and 9-15 are in condition for allowance.

Respectfully submitted,


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APPENDIX

1. A system including a digital camera and a docking unit to permit the digital camera to be coupled to a channel for communication with a service provider, comprising:

a) the digital camera including:

i) a viewable display;

ii) a lens for providing an optical image;

iii) an image sensor for receiving the optical image

provided by the lens to produce an image signal, a processor responsive to the image signal for producing a digital image so that the viewable display can respond to such image to provide a viewable image;

iv) a memory for storing a plurality of captured digital images having a first image size, and for storing a plurality of transferred digital images having a second image size, smaller than the first image size;

v) a docking interface to permit the digital camera to be connected to the docking unit; and a processor coupled to the memory for providing communication through the docking unit to a channel so that captured digital images stored in the memory are transferred over the channel to the service provider and transferred digital images are received over the channel from the service provider and stored in the memory, the processor further being couple to the viewable display so that the captured digital images and the transferred digital images stored in the memory can be viewed on the viewable display; and

b) the docking unit including:

i) a connector for receiving the docking interface in the digital camera and for connecting the digital camera to the docking unit;

ii) a power supply for providing power to the digital camera; and

iii) a network connection for interconnecting the docking unit to the channel for transferring captured digital images of the first size to the service provider and for receiving transferred digital images of the second size from the service provider.

2. The system of claim 1 wherein the processor further receives content files via the channel and causes information from such content files to be stored in the memory and to be displayed on the viewable display, the content files corresponding to content categories previously selected.

3. The system of claim 1 wherein the channel is the Internet and when the digital camera is connected to the docking unit, the processor automatically causes the connection over the Internet to a predetermined service provider, and the predetermined service provider automatically provides the plurality of transferred images to the channel for transfer to the memory in the digital camera.

4. The system of claim 1 wherein the captured digital images are stored as JPEG files in a first subdirectory and the transferred digital images are stored as JPEG files in a second subdirectory.

5. A system including a plurality of digital cameras, and docking units, and a service provider, to permit the digital camera to be coupled to the Internet, comprising:

- a) the digital camera including:
 - i) a viewable display;
 - ii) an image capture lens;
 - iii) an image sensor for receiving a visual image provided by the capture lens to produce an image signal, a processor responsive to the image signal for producing a digital image so that the viewable display can respond to such image to provide a viewable image;
 - iv) a docking interface to permit the digital camera to be connected to the docking unit; and
- b) the docking unit including:
 - i) a connector for providing an electrical connection with the docking interface in the digital camera; and
 - ii) a network connection for interconnecting the docking unit to the channel; and
- c) the service provider including a memory for storing a plurality of user accounts, each identifying particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories, and for communicating content information to a plurality of digital cameras associated with the plurality of user accounts, whereby the content information, corresponding to content categories identified in the service account

associated with each digital camera, is communicated over the Internet to the plurality of digital cameras; and

d) the digital camera receiving the content information and displaying the content information on the viewable display.

6. The system of claim 5 wherein the service provider also communicates digital image files over the Internet to the digital camera, and the digital camera receives and displays the digital image files on the viewable display.

7. The system of claim 5 wherein the content categories include at least one sports team selected by a particular user.

8. Canceled.

9. The system of claim 5 wherein the content categories include at least one stock selected by a particular user.

10. The system of claim 5 wherein the content category includes at least one sports category, a news category and a financial category.

11. The system of claim 1 wherein the processor reduces the size of the captured digital images prior to displaying them on the viewable display.

12. A method for providing communication over a channel between a service provider and a plurality of digital camera users, wherein digital camera has an associated docking unit, and the digital camera includes:

- i) a viewable display;
- ii) an image capture lens;
- iii) an image sensor for receiving a visual image provided by the capture lens to produce an image signal, a processor responsive to the image signal for producing a digital image so that the viewable display can respond to such image to provide a viewable image;
- iv) a docking interface to permit the digital camera to be connected to the docking unit; and

the docking unit includes:

- i) a connector for providing an electrical connection with the docking interface in the digital camera; and
- ii) a network connection for interconnecting the docking unit to the channel; and

the method including providing a memory for the service provider for storing a plurality of user accounts, each identifying particular content categories previously selected by a particular user, and content information corresponding to the plurality of content categories;

communicating content information to the plurality of digital cameras associated with the plurality of user accounts, whereby the content information, corresponding to content categories identified in the service account associated with

each digital camera, is communicated over the channel to the plurality of digital cameras; and

the plurality of digital cameras receiving the content information and displaying the content information on the viewable display.

13. The method of claim 12 wherein the content categories include sports teams.

14. The method of claim 12 wherein the content categories include financial categories.

15. The method of claim 12 wherein the content categories include sports themes.